

REMARKS

The Amendment, filed in response to the Office Action (“Action”) mailed December 22, 2008, is believed to fully address all issues raised in the Action. A favorable reconsideration of the application is respectfully requested.

Claims Disposition

Claims 1-7 were pending and considered in the Action. Claims 1-7 stand rejected in the Action.

Upon entry of the Amendment, which is respectfully requested, claims 1-4, 6, and 7 will all the claims pending in the application. In the Amendment, claim 1 is amended to incorporate the limitation of claim 5, and claim 5 is canceled accordingly. No new matter is introduced. The amendment is not believed to raise an issue which requires further search and/or consideration. Therefore, entry of the amendment is respectfully requested.

Drawings

Replacements drawings have been filed on September 6, 2006. Applicants respectfully request that the Office acknowledges the receipt of the Replacement drawings and indicate whether the Replacement drawings are accepted, in the next Action.

Response to Rejections under 35 U.S.C. § 103

1. **Response to Rejection of Claims 1-3, 4, 6, and 7**

In the Action, claims 1-3, 6, and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yokouchi *et al.*, US Patent No. 5,840,666 (“US ‘666”) as evidenced by Malec *et al.*, US Patent No. 3,637,501.

In the Action, claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over US ‘666 in view of Iso *et al.*, US Patent Application Publication No. 2002/0076125.

Without acquiescing the rejections, solely in order to compact the prosecution, claim 1 is amended to incorporate the limitations of claim 5, rendering the above two rejections under 35 U.S.C. § 103 moot. Withdrawal of the rejections of claims 1-4, 6, and 7 is respectfully requested.

2. Response to Rejection of Claim 5

In the Action, claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over US '666 in view of Koizumi *et al.*, US Patent No. hydro("US '841").

The Office asserts that the final grease composition of US '666 includes additives such as; antioxidants, rust preventatives, metal deactivators, etc (Col. 6/L. 34-49); and that the rust preventatives can be present in a total amount of up to 20 wt% of the finished grease composition and include, sorbitan esters. The Office correctly recognizes that the grease composition of US '666 does not include either of carboxylic acid or a carboxylate or amine based rust preventatives.

US '841 is relied on to cure the defect. The Office asserts that US '841 relates to a grease composition having improved rust-proofing properties, and the grease composition of US '841 comprises, ester based synthetic oils, and diurea thickeners, and can apply regardless of the kind of lubricating base oil and thickener (Col. 4/L. 13-32). The Office further contends that the grease composition comprises a lipophilic organic inhibitor such as carboxylic acid or carboxylate (Col. 2-3/L. 59-7) which acts as a rust preventative when used in combination with a hydrophilic organic inhibitor (Col. 2/L. 36-40), such as lanolin fatty acid amine ester and lanolin fatty acid alkanolamide (Col. 3/L. 18-28).

Applicants respectfully traverse.

US '666 was relied upon to reject original claim 5 (now incorporated into claim 1) under 35 U.S.C. § 103, in the previous Office Action. Therefore, Applicants' previous discussions and arguments related to original claim 5 and US '666 reference are incorporated herein by reference.

In response to the Applicants' arguments of unexpected results filed 9/25/2008, the Office asserts that the argument are not persuasive because the data is not commensurate in scope with the claimed subject matter of previously presented claim 1, and previously presented claim 1 does not address the rust preventative that is present in the compositions as presented in Tables 1 and 2.

Applicants respectfully submit that the currently presented claim 1 renders moot the Office's contention that claim 1 does not recite the rust preventatives that are present in the compositions in Tables 1 and 2.

Furthermore, as is clear from a comparison of the composition of Example 4 (Table 1 on page 24) and Comparative Example 1 (Table 1 on page 25), when two or more of the specific rust preventives (defined in the existing claim 5) are used in the specific amount (also defined in the existing claim 5), not only the improvement in the rust preventing properties but also the prevention in the high-temperature penetration change can be achieved.

Because the use of combination of the two or more of the specific rust preventatives allows significant prevention of high-temperature penetration change, a grease composition which contains such combination of rust preventatives retain excellent lubrication properties of aromatic ester oil at high temperature.

Applicants respectfully submit that US '666 and US '841, either alone or in combination, does not teach or suggest all and every elements of the composition defined in currently

amended claim 1. Neither do they teach or suggest functions and advantages of the claimed composition.

Therefore, Applicants believe that the rejection is not sustainable and respectfully request withdrawal thereof.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number **202-775-7588**.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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